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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,180	12/22/1999	JAY MERVES	72167.000112	5863

21967 7590 04/05/2007
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EXAMINER

CUFF, MICHAEL A

ART UNIT	PAPER NUMBER
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3627

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/470,180

Applicant(s)

MERVES ET AL.

Examiner

Michael Cuff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-38, 41-42 and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Ratnaraj et al.

Ratnaraj et al. shows, figure 1, an authenticated access to Internet based research and data services. In particular, the system is intended for financial data sets including those sets widely used at business schools, which include market research data (such as CRSP, Fama and Market Indices), corporate data (such as Compustat), and banking and insurance data (such as BEST and FDIC). Also see database sources 12-30 on figure 1. (The huge amount of data available in these data sources inherently incorporates many of the details in the dependent claims. The examiner assumes that

applicant is familiar with these sources and would know that daily, monthly and yearly reports; types of securities; issuers names; investors; and so are available. Please inform the examiner if there was a particular set of information that would be excluded from the Wharton Research Data System (WRDS)). There is a CGI (electronic screen) gateway available to generate reports. In a preferred embodiment, a procedure extracts time series data (historical financial performance data) from many different kinds of data files distributed by various data vendors and stores them in a SAS.RTM. data set.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 39, 40 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ratnaraj et al. in view of obviousness.

Ratnaraj et al., as applied above, shows all of the limitations of the claims except for specifying storing trustee reports, searching indenture documents, and searching for contact information.

The examiner takes Official Notice that an annual report (trustee document) would be obvious choice for one of ordinary skill in the art to consider as "other corporate financial reports" (column 4, line 41) in order to take advantage of it wealth of information in a relatively condensed form.

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Based on the teaching above, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the Ratnaraj et al. system to incorporate annual reports in its long list of data sources in order to take advantage of its wealth of information in a relatively condensed form.

The examiner takes Official Notice that, if a database stores data, it would be obvious to search or filter a search by any of the stored database fields in order to make use of the information.

Based on the teaching above, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the Ratnaraj et al. system to specify using the system for items in its raw database including contact information and indenture documents in order to collect data to facilitate contact with an entity or determining the financial status of an entity respectively.

Response to Arguments

Applicant's arguments filed 9/27/06 have been fully considered but they are not persuasive.

Applicant asserts Ratnaraj has no reference to any type of structured securities transaction. The examiner does not concur. The examiner provides Barton, III et al. (6,026,381), Table 1, column 15, as evidence, not part of the rejection, to show that mortgage-backed securities are included in CUSIP classification. Column 6 of Ratnaraj describes the use of the CUSIP numbers in the search fields. There are many other search fields provided including dates and identities. Applicant's own disclosure, page

3, lines 5-8, shows that applicant's reports (these reports must include all the fields applicant is claiming in order for the claims to be enabled) are posted on the Internet.

Applicant asserts that claim 1, by means of antecedent basis, claims retrieving search results that consist only of securities underlying structured securities transactions. The examiner does not agree with applicant rationale, but it is moot because Ratnaraj allows for a filter to any group (column 8, lines 6-11), thus meeting the "only" requirement.

Applicant has traversed examiner's Official Notice. The Black et al. (6,012,042) reference, column 3, lines 44-58, is provided as evidence to show what is well-known in data collection in the security analysis field.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Barton, III et al. and Black et al. are references used as evidence to support the examiner's position on what is included in the primary reference.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cuff whose telephone number is (571) 272-6778. The examiner can normally be reached on 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael Cuff 4/2/07

Michael Cuff
April 2, 2007